

AMENDMENT UNDER 37 C.F.R. § 1.111

US Application No. 09/913,885

Attorney Docket No. Q65570

REMARKS

Claims 1-16 are now all the claims pending in the application. Claims 1-9 have been amended to make the claims broader by eliminating unnecessary limitations. New claims 10-18 have been added, and contain no new matter.

The objection to the Information Disclosure Statement.

In the Office Action, the Examiner asserted that the information disclosure statement filed in 2001 fails to comply with the rules because it does not include a concise explanation of the relevance of references not in the English language.

In response, Applicant draws the attention of the Examiner to the copy of a corresponding communication from a foreign patent office that cited the documents not in English language, and which included a portion indicating the degree of relevance found by the foreign office. In accordance with rule 98, this satisfies the concise explanation requirement.

Applicant thus urges the Examiner to reconsider his position that the information disclosure statement did not comply with the rules, and to give the foreign-language references the consideration that is required in view of the fact that Applicant has fully complied with the rules.

The specification.

The Examiner asserted that the content of the specification lacks some relevant sections, such as the background of the invention, the summary of the invention, the brief description of the drawings, etc.

It seems that the Examiner has overlooked or ignored the preliminary amendment that was filed concurrently with the request to enter the national stage (August 17, 2001). This preliminary amendment was resubmitted on April 12, 2002, because the USPTO apparently lost the original copy of the preliminary amendment. In the preliminary amendment, the relevant section headings were added to the specification.

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Applicant respectfully requests the Examiner to browse the file to locate the preliminary amendment, and thereby give it proper consideration.

The rejection under §112.

The Examiner rejected claims 1, 2, and 8 under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicant respectfully requests the Examiner to withdraw this rejection. The broadening claim amendments made above include changes that should take care of the Examiner's concerns.

The prior art rejections over Willhoff.

The Examiner rejected claims 1, 2, 4, 5, 7, and 8 under 35 U.S.C. § 102 (e) as being anticipated by Willhoff. Applicant respectfully traverses this rejection, first with respect to independent claim 1, as now amended, in view of its requirement for:

terminating the setting up of the call
channel once the user message has been
communicated.

In making this rejection the Examiner asserted that Willhoff meets this requirement by virtue of the teachings provided at col. 7, lines 30-33.

Applicant respectfully requests the Examiner to reconsider this point. At col. 7, lines 30-33, Willhoff is discussing Block E (it says "D" but that block is described already at lines 11-17) of Fig. 4. That is to say, what Willhoff is mentioning here is a call take down procedure, which is different from terminating a call set up procedure.

In Willhoff, the call set up is performed at Block B of Fig. 3 and Block A of Fig. 4. The traffic channel is assigned at Block C. The Willhoff sending of the message(s) occurs after the channel is set up and assigned. In other words, Willhoff sends the messages over an already set up traffic channel, and not as a signaling message before the terminating of the *setting up* of the call, which is required for normal traffic to pass.

The claim requires "terminating the setting up of the call channel once the user message has been communicated." In Willhoff, the terminating of the setting up of the call occurs clearly

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before the sending of the user messages can occur. This is because the user messages cannot be sent until the call channel is completely set up and the channel is assigned.

It *would be unreasonable*, however, to interpret the requirement for “terminating the setting up of the call channel once the user message has been communicated” as meaning that the setting up of the call channel is *terminated before* the user message has been communicated. In Willhoff, the setting up of the call channel is not terminated until the call channel is set up and assigned. After that, the Willhoff user message(s) can be sent.

In the specification of the present application, which Applicant understands does not limit the claims, the following problem is identified:

When transmitting mini-messages, such a procedure poses problems. At the scale of a mini-message, the time required to set up a call, plus the call time, plus the time required to clear down the call give a transmission time that is too burdensome.

(page 1, lines 29-33). Willhoff takes exactly this approach that is said to be “too burdensome.” In fact, Willhoff has an objective “to provide a method for message transmission that is unconstrained by ... message length restrictions.” (col. 2, lines 46-48).

As a more deliberate study of the teachings of Willhoff reveals, the goals of Willhoff are almost opposite to those of the inventions defined in the claims; the subject matter of Willhoff is not the same as that required by the claims; and the teachings of Willhoff certainly do not anticipate the subject matter of even independent claim 1 (especially the requirement for “terminating the setting up of the call channel once the user message has been communicated.”).

Willhoff lacks the requirement for placing the user message in a spare field of a signaling message; Willhoff uses a field of a traffic message. Willhoff lacks the requirement for sending the signaling message in a signaling stage; Willhoff sends the traffic message after the signaling stage is already over. Willhoff lacks the requirement for terminating the setting up ... once the user message has been communicated; Willhoff terminates the setting up of the call before the traffic message can be communicated.

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Applicant thus respectfully submits that Willhoff does not anticipate claim 1 within the meaning of 35 U.S.C. § 102, and Applicant respectfully requests the Examiner to withdraw this rejection of not only independent claim 1, but also its dependent claims.

Independent claim 8, as now amended, requires:

the processor is adapted also to send the
signaling message during a call set-up
operation

As explained above, Willhoff neither teaches nor suggests such a processor. Applicant therefore respectfully requests the Examiner to withdraw this rejection of independent claim 8.

The rejection under 35 U.S.C. §103(a).

The Examiner's rejection of claims 3, 6, and 9 as being unpatentable over Willhoff is respectfully traversed. Claims 3 and 6 depend from claim 1, ultimately, and claim 9 depends from claim 8. Applicant has already demonstrated that teachings of Willhoff do not suggest the subject matter of either independent claim 1 or independent claim 8. Indeed, Willhoff's teachings are in an opposite direction: Willhoff is concerned with making longer and longer messages possible whereas Applicant's originally-filed specification is drawn to mini-messages with an eye toward reducing network burdens. The artisan of ordinary skill, confronted with the teachings of Willhoff, would not have (and could not have) adapted Willhoff's teachings in any manner to produce the subject matter of independent claims 1 or 8, much less that of dependent claims 3, 6, and 9.

Applicant therefore respectfully requests the Examiner to reconsider and to withdraw this rejection.

New claims 11-16.

New claims 11-16 are similar in many respects to claims 1-7, as now amended. The only new independent claim is claim 11, and claims 12-16 ultimately depend from claim 11. Claim 11 is respectfully submitted to patentably distinguish over Willhoff in view of its requirement for:

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terminating the setting up of the call channel once a reply to the user message has been received.

This requirement is not met in Willhoff. The terminating of "the setting up of the call channel" must take place once a reply has been received. Willhoff does not even send the user message until the set up of the call channel is over. Therefore, Willhoff does not meet this requirement.

In view of the foregoing, Applicant respectfully solicits of the Examiner the allowance of claims 11-16.


Conclusion and request for telephone interview.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860


Kelly G. Hyndman
Reg. No. 39,234

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

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